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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,057	01/22/2001	Ursula Murschall	00/050 MFE	8999

38263 7590 12/15/2004
PROPAT, L.L.C.
425-C SOUTH SHARON AMITY ROAD
CHARLOTTE, NC 28211-2841

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT PAPER NUMBER

1774

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,057

Applicant(s)

MURSCHALL ET AL.

Examiner

Lawrence D. Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-16,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-16 and 19 is/are allowed.
- 6) ☒ Claim(s) 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed October 1, 2004.

Claims 1, 15 and 20 were amended rendering claims 1, 3-16 and 19-20 pending

Claim Rejections – 35 USC § 102(b)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 20 is rejected under 35 U.S.C. 102(b) as being unpatentable over Kim et al. (U.S. 5,660,931).

Kim shows a white film (core layer) having a polyester comprising polyethylene terephthalate (crystallizable thermoplastic) (column 3, lines 61-63), barium sulfate (column 1, line 61 through column 2, line 5), and bisbenzoazole (optical brightener) (column 5, lines 13-22). The reference shows UV light resistance (column 8, lines 30-36). In claim 20 the phrases, “masterbatch that has been at least one of either (i) predried or (ii) precrystallized” and “masterbatch carrier polymer that has been at least one of either (i) predried or (ii) precrystallized, introduce process limitations to the product claims. The patentability of a product does not depend on its method of

production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims. Kim shows that the white film has a thickness of 12 micrometers (column 9, lines 11-16). The reference shows the film comprises polyester, has hiding power (opacity), a thermal stabilizer (column 2, lines 22-28), a coating (column 2, lines 37-45 and column 3, lines 1-4) and alkali earth material (column 2, lines 35-45). Kim further shows the thermal stabilizer prevents thermal decomposition as well as increases heat resistance (flame retardant) (column 6, lines 29-35) and the stabilizer consists of 2-hydroxybenzophenone (column 6, lines 49-58).

Response to Arguments

4. Objection of claim 15 is withdrawn due to Applicant amending the claim. The obviousness-type double patenting rejection is withdrawn due to amendments made to instant claim 1 and remarks submitted by Applicant.

Rejections made under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (U.S. 5,660,931), Kim et al. (U.S. 5,660,931) in view of von Meer (U.S. 4,384,040) and further in view of Asai et al. (U.S. 5,178,943) are withdrawn due to Applicant amending instant claim 1 to include a single thermoplastic and a yellowness index of less than or equal to 45 for 250 micron films and less than or equal to 20 for 50 micron films; however claim 20 remains unpatentable under Kim et al. Applicant argues Kim does not teach a predried and/or

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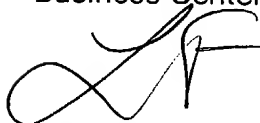
precrySTALLIZED masterbatch carrier polymer. Examiner maintains "masterbatch that has been at least one of either (i) predried or (ii) precrySTALLIZED" and "masterbatch carrier polymer that has been at least one of either (i) predried or (ii) precrySTALLIZED, introduce process limitations to the product claims.


Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lawrence Ferguson
Patent Examiner
AU 1774


RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 12/06/04